



Attorney Docket No. 051252-5140
Application S.N. 09/313,407
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S. Little
8/27/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Jack LORRAINE, et al.)
Application No.: 09/313,407) Group Art Unit: 3747
Filed: May 18, 1999) Examiner: C. Miller
For: FUEL INJECTOR MOUNTING)
ARRANGEMENT)

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w/
Ext. 3 mos

Commissioner for Patents
Washington, D.C. 20231

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TECHNOLOGY CENTER R3700

Sir:

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REQUEST FOR RECONSIDERATION
UNDER 37 C.F.R. § 1.111

In response to the non-final Office Action mailed **February 22, 2002**, the period for response being extended through August 22, 2002, with a petition for a three-month extension of time accompanying this paper, reconsideration of the application in view of the following remarks is requested.

The Office Action issued February 22, 2002 has been reviewed and the comments of the U.S. Patent and Trademark Office have been considered. Accordingly, Applicants request reconsideration of the pending claims 1-18.

Claims 1-18 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to provide a written description that conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, and allegedly failing to enable a person skilled in the relevant art to make and use the invention commensurate with the claims. In particular, the Office Action alleges that the application fails to mention a wall section length being shorter than a leg length, as recited in claims 1, 8, 12, and 15. ✓

Applicants respectfully assert that, at the time of filing of this application, the inventors had possession of the claimed invention, which includes, *inter alia*, a length of a wall section

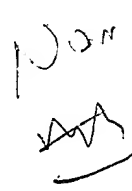
along the longitudinal axis being less than the length along the longitudinal axis of each leg. As stated in MPEP §2163, “[a]n applicant shows possession of the claimed invention by describing the claimed invention ... using such descriptive means as words, structures, figures, diagrams and formulas that fully set forth the claimed invention.” Applicants submit that the originally filed application evidences that Applicants had possession of the claimed invention in view of originally filed Figs. 1-4, and the originally filed textual description for these figures. For example, the exemplary components of the fastener 18 or clip 40 are depicted in Figs. 3 and 4 in a manner that is believed to illustrate the size of each feature relative to each other. That is, the length of the wall 42 along the longitudinal axis being less than the length of each leg (42a or 42b) along the longitudinal axis has been illustrated in the exemplary embodiment of Figs. 3 and 4 so as to render unnecessary an explicit textual description of the relative sizes of these components. Thus, one skilled in the art would appreciate that the originally filed Figures 1-4 illustrate the relative sizes of the features of the clip so as to clearly support the recited features, and that the originally filed application, including the drawings, unequivocally conveys that the inventors had possession of the claimed invention. Accordingly, the rejection for allegedly failing to provide a written description should be withdrawn.

Furthermore, as stated in MPEP §2164.01, the standard for determining enablement of a claimed invention, based upon the disclosure of the application, rests on whether one skilled in the art would be able to make or use the claimed invention without “undue experimentation.” The features of the fastener or clip recited in the claims includes, in part, a wall and a pair of legs such that the length of the wall is less than the length of either leg as referenced with respect to the longitudinal axis. The originally filed application, including Figs. 1-4, provides a depiction of a mounting arrangement, including a fastener or clip, with the relative size of each feature of the fastener or clip illustrated in relation to each other. Applicants respectfully submit that one skilled in the art, in view of the originally filed application and drawings, would be able to make and use the claimed invention without undue experimentation due to the detailed nature of the textual description and drawings provided in this application. Accordingly, this rejection should also be withdrawn.

Claims 1-10 and 12-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,136,999 to Bassler et al., ("Bassler") in view of U.S. Patent 6,019,089 to Taylor et al., ("Taylor"). Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bassler and Taylor and in view of U.S. Patent 5,752,487 to Harrell et al., ("Harrell").

Applicants respectfully traverse these rejections because Bassler and Taylor, singularly or in combination, fail to teach or suggest the claimed invention as a whole, as recited in claims 1, 8, 12, and 15.

Each of the independent claims 1, 8, 12, and 15 recites, *inter alia*, a wall and a pair of legs of a fastener (or clip) projecting from the wall of the fastener. Further, a length of the wall is less than the length of each leg with respect to the longitudinal axis.

In sharp contrast, Bassler states, at column 3, lines 11-20, that two segments 27, 28 extend from the web member 20 that interconnects spring legs 18 and 19. As shown in Figure 3 of Bassler, the length of the segments 27 (being part of the web 30) extends beyond a length of the either spring leg 18 or 19 as referenced to the longitudinal direction of the fuel injector of Bassler. Thus, a length of the web 20 (shown as segments 27) is greater than a length of each of the spring leg 18 or 19 as referenced with respect to the longitudinal direction **instead** of being less than the length of each leg as recited in claims 1, 8, 12, and 15. 

Notwithstanding the deficiencies in Bassler, the Office Action asserts that it would have been obvious to modify Bassler based upon the teachings of Taylor to increase the axial movement of the injector within the clip of Bassler. Taylor states, at column 4, lines 10-15, that an orientation tab 46 extends from the body 44 and a shorter tab 48 also extends from the body 44. As can be seen in Figure 1 of Bassler, the length of the segments 27 is greater than the length of the spring leg 18 or 19, whereas in Taylor, the length of the body 44 is much less than a length of the tab 46 or 48 of Taylor. Therefore, it is submitted that the proposed combination of Bassler and Taylor would necessarily destroy the holding feature of the segments 27 (column 3, lines 58-61) of Bassler in an attempt to reach the claimed invention as a whole. And as noted in MPEP §2143.01, "[i]f the proposed modification would render the prior art invention unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed

modification.” Thus, there is no suggestion or teaching in Taylor to modify Bassler to achieve the claimed invention as a whole because the proposed modification would render Bassler unsatisfactory for its intended purpose. Accordingly, the rejection to claims 1, 8, 12, and 15 should be withdrawn, because the claimed invention as a whole recites features not taught or suggested by Bassler or Taylor, singularly or in combination thereof.

The Office Action further relies upon the teachings of Harrell in combination with Bassler and Taylor to allegedly render obvious the mounting arrangement of claim 11. However, Harrell fails to cure the deficiencies identified above in Bassler or Taylor. Accordingly, claim 11 is patentable over Bassler, Taylor or Harrell, singularly or in combination thereof.

Claims 2-7, 9, 10, 13, 14 and 16-18 depend ultimately from respective independent claims 1, 8, 12 and 15, are therefore also allowable for at least the same reason as claims 1, 8, 12, and 15, as well as for reciting additional features.

Conclusion

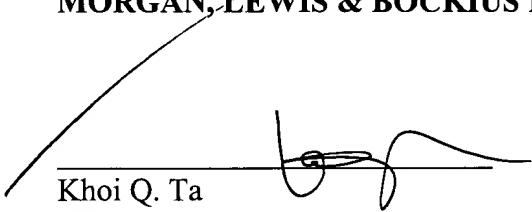
In view of the foregoing remarks, Applicants respectfully request the reconsideration and allowance of claims 1-18. Applicants respectfully invite the Examiner to contact the undersigned at (202) 739-5203 if there are any outstanding issues that can be resolved via a telephone conference.

EXCEPT for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. §1.136(a)(3).

Respectfully submitted,

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Date: 22 August 2002


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